

**AMENDMENTS TO THE DRAWINGS:**

The attached sheets of drawings include replacement sheets for Figures 2 and 4.

In replacement Figure 2 reference numeral "22" has been changed to "22a."

In replacement Figure 4 reference numerals "12a," "21a," "21b," "26," and "34" have been added.

Attachments:    **Replacement Sheets** for Figures 2 and 4.

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner objected to the drawings; objected to the specification and claims 1-6; rejected claim 1 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,896,403 B1 to Grau et al. ("*Grau*"); rejected claims 1, 2, and 6 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,025,494 B2 to Oomori et al. ("*Oomori*"); rejected claims 1, 2, and 4 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,349,075 B1 to Miyauchi et al. ("*Miyauchi*"); and rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Miyauchi* in view of Applicant Admitted Prior Art ("*AAPA*").

Applicants have amended Figures 2 and 4 and the specification. Claims 1-6 remain pending in this application.

**I. Objections to the Drawings**

On pages 2-3 of the Office Action, the Examiner objected to the drawings for failing to meet the requirements of 37 CFR 1.83(a). Applicant respectfully traverses the objections. However, in order to advance prosecution, Applicant has amended the drawings as indicated in the attached Replacement Sheets for Figures 2 and 4. The amendments to Figures 2 and 4 are fully supported by the original disclosure of the present application and, furthermore, address the issues raised by the Examiner.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the objections to the drawings.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

**II. Objections to the Specification and Claims 1-6**

In the Office Action, the Examiner objected to the specification and claims 1-6 asserting that the specification does not enable one of ordinary skill in the art to understand, for example, “how to construct/use ‘an assembly member connecting said movement to said case.’” Applicant respectfully traverses.

First, with respect to the amendments to the specification and drawings (Figures 2 and 4), these amendments clarify the relationship between the movement and case. Based on the original disclosure of the application, one of ordinary skill in the art would readily understand that the movement is free to rotate or be displaced relative to the case. In fact, such arrangements are generally known in the art (see, e.g., CH 141094).

Second, it appears that the Examiner has misinterpreted the specification of the present application. For example, the Examiner concludes that “the movement is attached to the housing by means 22 figure 2. Said attachment is achieved with screws 22b and 22c. Subsequently, the movement would be attached in a fixed, non-rotating manner.” (Office Action, page 4.) However, this interpretation is incorrect. The specification teaches that bridge 22a of assembly member 22 is attached to case 10 and to plate 12a. (See p. 3, ll. 17-19). It only derives from this that plate 12a of the oscillating mass is attached to case 10. Since movement 12 is able to rotate about the pivot axis of plate 12a (see p. 3, ll. 19-20), movement 12 is able to rotate freely in the housing of the case. Therefore, an enabling disclosure is provided for claims 1-6.

For at least the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the objections to the specification and claims 1-6.

**III. Rejections of Claims 1, 2, 4, and 6 under 35 U.S.C. §102(e)**

Applicant respectfully traverses the rejections of claims 1, 2, 4, and 6 under 35 U.S.C. § 102(e) as being anticipated by *Grau*, *Oomori*, and *Miyauchi*.

In order to properly establish that *Grau*, *Oomori*, or *Miyauchi* anticipate Applicant's claims each and every element of the claims must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 recites a watch including, *inter alia*, "a case defining a housing", "a movement arranged inside said housing," and "an assembly member connecting said movement to said case" in which "said assembly member allows said movement to be displaced with reference to said case." *Grau*, *Oomori*, and *Miyauchi* fail to disclose or teach at these features of claim 1. Among other things, the "movement" of *Grau*, *Oomori*, and *Miyauchi*, to the extent such structure can be identified in each of the references,<sup>2</sup> is fixed and can not be rotated or otherwise displaced with reference to the case, as required by claim 1. This is even true with respect to the isolated structures identified by the Examiner, such as motors 41-44 of *Grau*.

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<sup>2</sup> In the Office Action, the Examiner did not correctly identify the "movement" in the asserted prior art references, as that term is ordinarily interpreted in the field of horology. For example, item "102" of *Oomori* is not a movement of a watch, but rather a clockface. (See *Oomori*, C. 8, ll. 57-61.)

Moreover, other features of claim 1 are neither disclosed nor suggested by the prior art. For example, claim 1 additionally requires "a control system accessible from outside of said case intended for correcting said display organs," wherein the control system includes "a button accessible from outside said case and capable of being displaced by an application of pressure toward said movement, from an initial position." *Grau*, *Oomori*, and *Miyauchi* plainly do not disclose or teach these features of claim 1.

For at least the foregoing reasons, independent claim 1 is patentable over *Grau*, *Oomori*, and *Miyauchi*. Furthermore, claims 2, 4, and 6 depend from claim 1 and are also allowable over the prior art at least due to their dependence from claim 1.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(e) rejection of claims 1, 2, 4, and 6.

#### **IV. Rejection of Claim 3 under 35 U.S.C. §103(a)**

Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claim 3 because a *prima facie* case of obviousness has not been established with respect to claim 3.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P.* § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P.* § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary

skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III)*, internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

Claim 3 depends from claim 1 and thus requires all of the elements of claim 1. As discussed above, *Miyauchi* does not teach or suggest each and every element of independent claim 1. Moreover, the *AAPA* identified by the Examiner fails to cure the deficiencies of *Miyauchi* with respect to claim 1. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1 or 3.

Accordingly, for at least the above-noted reasons, Applicant requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claim 3.


### **CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of all pending claims. As demonstrated above, the claims are neither anticipated nor rendered obvious by the prior art references cited against this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

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